

Appln No. 09/517,384
Amdt. Dated 24 January 2005
Response to Office Action of 2 December 2004

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REMARKS/ARGUMENTS

35 USC 102

The Examiner raises US Patent No. 4,710,613 (Shigenaga) to assert anticipation of claims 1, 3 – 5, 7 – 11 and 13 – 15 under 35 USC 102(b).

Independent claims 1 and 7 have been amended to differentiate the claimed invention from Shigenaga. Claims 1 and 7 now recite that the untrusted authentication chip is contained within a consumable and the trusted authentication chip is contained within a consuming device.

Support for this amendment is found, for example, at page 4, lines 11 – 17 of the present specification. Further support can be found, for example, in the discussion of consumables at page 41, line 6 to page 42, line 28.

A consumable, by its definition, is intended to be used up and then replaced. A consuming device is the device that consumes the consumable. Currently amended claims 1 and 7 are now directed to a validation protocol and a validation system, respectively, for use in conjunction with a consuming device and a consumable.

Referring to Shigenaga, there is only disclosure of an IC card used in conjunction with an IC card terminal. Used in conjunction with a Personal Identification Number (PIN), Shigenaga discloses a system of authorisation for use of the IC card.

At page 5 of the Office Action, the Examiner, in referring to claim 11, considers that Shigenaga discloses a system in which the IC card is a consumable. It is respectfully submitted that such an interpretation is inconsistent with the normal English meaning of the term "consumable". The IC card is not consumed by the IC card terminal (which is not a consuming device).

In the present invention, a consumable is a device which needs to be replaced, for example, as disclosed at page 4 of the specification, a print roll, an ink cartridge, a toner cartridge, etc.. The applicant desires to make clear that the term consumable should not be considered to be limited to only these devices, however, the applicant asserts that it is clear that a consumable is not an IC card.

Furthermore, it is respectfully submitted that one of ordinary skill in the art is not taught how to produce the presently claimed invention, as defined in claim 1 or 7 in light of Shigenaga. There is no teaching, suggestion or motivation found in Shigenaga, or other prior art documents of record, that would motivate one of ordinary skill in the art to modify the teachings of Shigenaga for use in a consumable and a consuming device. Shigenaga is directed to confirming authorization of a user to use an IC card. Shigenaga is not concerned with the long standing problems associated with authenticating a consumable to prevent inferior refill operations or clone manufacturing of consumables. Existing solutions to the ongoing problem of authenticating consumables have typically relied on unique packaging or physical interconnections which does not teach or suggest to one of ordinary skill in the art that the disclosures in Shigenaga would find application in the problem of authenticating consumables.

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35 USC 103

It is respectfully submitted that the foregoing amendments and remarks exhibit the patentability of claims 1, 3 - 5, 7 - 11 and 13 - 15. As such, the Examiner's rejection against claims 2, 6, 12 and 16 under 35 USC 103(a) as being unpatentable over Shin *et al.* is traversed as each of these claims is dependent on either independent claim 1 or 7, and therefore incorporates the features of the respective base claim.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 USC 102(b) and 35 USC 103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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